

REMARKS

It is respectfully requested that the above amendments be entered pursuant to the provisions of 37 C.F.R. §1.116(b); that this application be reconsidered in view of the above amendments and the following remarks; and that all of the claims remaining in this application be allowed.

Amendments

Applicants have requested that Claim 1 be amended to specifically indicate that Ar¹ through Ar⁴ are independently 1-alkylpyrrole wherein the pyrrole rings are attached to the amino group at the 4-position and the carbonyl group at the 1-position. Support for this amendment is found in Applicants' specification at, for example, page 27, lines 4-11. Formula I was amended to reflect this change and R was inserted to define the alkyl and cycloalkyl substituent at the 1-position of the pyrrole moiety.

Applicants have requested that Claims 3, 8, 10 and 12 be amended to place these claims into independent form. In addition, the requested amendments for Claims 8, 10 and 12 include the same recitation for Ar¹ through Ar⁴ as found in amendments requested for Claim 1.

Claim 14 has been amended to ensure that the claim is dependent on currently pending claims only.

Claim 7 has been amended to remove the pyrene-1-ylmethoxy group.

Claims 2, 5, 15-19 and 22 have been canceled without prejudice or disclaimer.

Applicants note that each of the above amendments has been requested solely to expedite allowance of what is believed to be allowable subject matter. Applicants reserve the right to file one or more continuation/divisional applications directed to the previously presented subject matter.

Applicants submit that each of the requested amendments either places the claims in a better condition for appeal and/or comply with a restriction requirement entered in this application. Accordingly, entry of these amendments pursuant to the provisions of 37 C.F.R. §1.116(b) is proper. Entry of these amendments is requested.

Upon entry of these amendments, Claims 1, 3-4, 6-14 and 20-21, are pending in this application.

For the convenience of the Patent Office, a conformed copy of the pending claims is attached hereto which copy presumes that the requested amendments will be entered.

Rejections under 35 U.S.C. § 112, first paragraph

Claim 15 stands rejected under 35 U.S.C. § 112, first paragraph, because the specification allegedly does not reasonably provide enablement for the treatment of any disease caused by pathogenic organisms wherein said organisms are selected from the group consisting of bacteria, fungi, and parasites. While not acquiescing in this rejection, Applicants have canceled Claim 15 without prejudice or disclaimer. Withdrawal of this rejection is earnestly solicited.

Rejections under 35 U.S.C. § 112, second paragraph

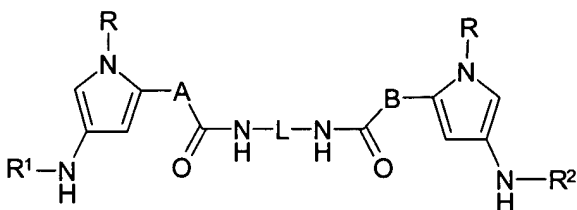
Claim 16 stands rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. While not acquiescing in this rejection, Applicants have canceled Claim 15 without prejudice or disclaimer. Withdrawal of this rejection is earnestly solicited.

Claim Objections

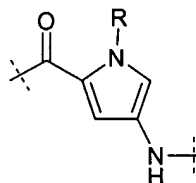
Claims 1-14, 20 and 21 stand objected to as allegedly containing non-elected subject matter.

In response, Applicants reiterate the traverse of the unofficial restriction requirement made by the USPTO in the Action mailed on February 10, 2003 (paper no. 9) and request that this restriction requirement be withdrawn.

Specifically, the now presented claims are all directed to a core structure as follows:



where R, R¹ and R² are as defined in the claims and A and B are optionally repeating units of the formula:



connected in such a manner that amide bonds are formed between each of the pyrrole groups.

Initially, Applicants respectfully assert that the original restriction requirement as set forth in the Office Action of November 29, 2003 was improper. The restriction requirement was in error because under the statute (35 U.S.C. § 121, MPEP 802 and 803), restriction is appropriate when two or more *independent and distinct* inventions are claimed in one application. As explained above, in their response, Applicant presented evidence that there appeared to be direct overlap among the compounds of Groups I – III -- that is to say that the compounds of Group II and III were subgeneric to those of Group I. Accordingly, it was impossible to determine in which group a given compound belonged. Since there is direct overlap among the Groups as defined by the Examiner, the Groups do not define independent and distinct inventions.

However, to further compacted prosecution of this application, Applicants have requested that Claim 1 be amended to recite a compound of Formula (I) that has a common backbone as described above. Applicants respectfully assert that the claimed compounds as amended clearly exhibit unity of invention. Moreover, the USPTO has not alleged that the claims of this application lack unity of invention.

Secondly, Applicants submit that it is improper for the Office to refuse to examine that which Applicants regard as their invention when the subject matter of the claims exhibits unity of invention. (MPEP 803.02). Specifically, in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978), the court articulated the general proposition that:

“[A]n applicant has a right to have *each* claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification.”

Id. at 331.

In view of the above and similar case law, the Patent Office has set forth a general policy regarding restriction of Markush-type claims in MPEP 803.02. According to the general policy as articulated in the MPEP, “since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334, it is *improper* for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984).” (MPEP 803.02, emphasis added). Unity of invention exists where compounds included within a Markush group (1) share a common utility and (2) share a substantial structural feature. (MPEP 803.02).

Accordingly, Applicants submit that it is improper for the Office to refuse to examine the presently claimed invention since the presently claimed subject matter clearly evidences unity of invention.

Furthermore, Applicants assert that even where a provisional election of a single species is proper prior to examination on the merits, following election the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. (MPEP 803.02). The MPEP requires that should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim *will be* extended to non-elected species (plural). (Id.). The MPEP states that the search need not be extended unnecessarily to cover all non-elected species; however, the MPEP states that Applicant is entitled to consideration of claims to a *reasonable number of disclosed species* in addition to the elected species. (MPEP 809.02(b), emphasis added). The USPTO has not contested that the number of species claimed in this application is reasonable.

Moreover, as noted in MPEP §803, restriction is improper if the search and examination of the entire patent application can be made without a serious burden to the Examiner. In the present case, the common structural backbone of the now claimed invention necessitates that a proper search of all of the claims will not pose a serious burden on the Examiner. Accordingly, Applicants submit that it is inequitable and unjust for the Examiner to limit Applicant's claim in the manner in which has done so. If the restriction requirement is maintained, to obtain coverage of the compounds, which Applicants regard as their invention, Applicant will be required to file countless patent applications, thus placing an unreasonable and unjust burden on the Applicants.

In the present Office Action, the Examiner improperly withdrew subject matter from consideration based on a selection of groups within Markush groups and a revision of Claim 1 arbitrarily chosen by the Examiner. This is improper as it does not comply with MPEP 802 and 37 CFR 1.142, which indicate that the requirement for restriction and state that "the examiner in an Office action *will require the applicant* in the reply to that action *to elect an invention....*"

In addition to improperly restricting Applicants invention, the Examiner improperly searched Applicants invention. MPEP 803 clearly states that when an election of species was required by the Examiner, that the Examiner must search all elements of a Markush group unless and until prior art is found.

"The provisional election will be given effect in the event that the Markush-type claim should be found not allowable. Following election, *the Markush-type claim will be examined fully* with respect to the elected species *and further to the extent necessary to determine patentability*. If the Markush-type claim is not allowable over the prior art, examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.... On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended." MPEP 803.02

Because no prior art references are cited and 35 U.S.C §102 or 35 U.S.C §103 rejections are presented, Applicants presume no art was found, and as such the Examiner was required to extend the search to cover the Markush group fully.

Applicants submit the further restriction of Claim 1 and the subsequent withdrawal of matter from consideration is improper and request that Claim 1 be searched in its entirety or until prior art is uncovered as required by MPEP §803.02. In the absence of withdrawal of this restriction requirement, a petition to Commissioner for such action will be submitted.

In view of the above, Applicants submit that this application is now in condition for allowance. A Notice to that effect is earnestly solicited.

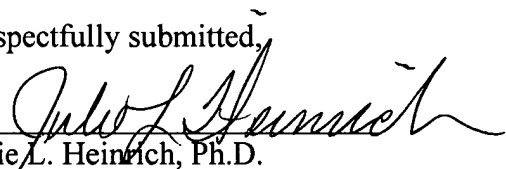
CONCLUSION

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 50-2859** referencing docket no. 554912000200. However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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